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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,422	09/21/2005	Bruce Leigh Kiehne	A-9488	4461
7590 Hoffman Wasson & Gitler 2461 South Clark Street Suite 522 - Crystal Center Arlington, VA 22202		08/04/2009	EXAMINER SZPRA, JULIE ANN	
			ART UNIT 3731	PAPER NUMBER
			MAIL DATE 08/04/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/528,422

Applicant(s)

KIEHNE, BRUCE LEIGH

Examiner

JULIE A. SZPIRA

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/11/2009 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1-11** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite. At line 8, it is unclear how and by what means the tab is to prevent the cutting edge of the blade from being exposed. Without further clarification as to how the tab is to prevent exposure, it is unknown if the tab is to cover a cutting edge, stop movement of the blade in forward direction, etc. Claims 2-11 are also rejected for being dependent on a rejected claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claims 1-8 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kiehne (WO 01/05312)** in view of **Gringer (US 6,085,607)**.

Regarding claim 1, Kiehne discloses a safety scalpel blade assembly adapted for attachment to a handle of the type which has a blade carrier in the form of a finger (14), the assembly comprising a scalpel blade (10) which can be of conventional manufacture, the scalpel blade having a slot (13) to allow the blade to be attached to the blade carrier on the handle, and a guard (11) which extends at least about the cutting edge of the blade (page 7, lines 17-19), the guard having attachment means (buttons and recesses) to lock the blade to the guard as the assembly is being attached to the handle and which releases the blade from the guard when the blade is attached to the blade carrier on the handle (page 9, lines 24-32 and page 10, lines 1-6).

Kiehne fails to disclose a removable tab on the guard having a portion which can be gripped by a person.

However, Gringer teaches a removable tab (extension) that can be gripped by a person (column 9, lines 19-26).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a removable tab to limit the movement of the blade while the tab is in place (column 3, lines 22-25).

Regarding claim 2, Kiehne discloses the device substantially as claimed above, but fails to disclose the removable tab having a head portion and a tail portion.

However, Gringer teaches the removable tab having a head portion and a tail portion (the two portions separated by notches in the tab), the head portion extending forwardly of the blade assembly, and the tail portion extending at least partially into a slot which is present in the guard (column 9, lines 23-35).

Regarding claim 3, Kiehne discloses the device substantially as claimed above, but fails to disclose the removable tab attached via at least one breakable portion.

However, Gringer teaches the removable tab having notches to allow for the tab to be broken away (column 9, lines 23-27)

Regarding claim 4, Kiehne in view of Gringer discloses the device substantially as claimed above, but fails to specifically disclose the breakable portion comprising a first portion and a second portion.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make more than one breakable portion since it has been held

that mere duplication of essential working parts (breakable portions) of a device involves only routine skill in the art.

Regarding claim 5, Kiehne discloses the device substantially as claimed above, but fails to disclose the first breakable portion being close to the head portion of the removable tab, and breaking more easily than the second breakable portion.

However, Gringer teaches a first breakable portion closer to the head of the tab (Figure 50; column 9, lines 23-27).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the first breakable portion closer to the head portion of the removable tab since it would be easier to remove the tab in that configuration (column 9, lines 25-27)

Regarding claim 6, Kiehne discloses the device substantially as claimed above, but fails to disclose an anti-lift means.

However, Gringer teaches a support structure designed to limit the ability of the blade carrier to move within the housing (guard) (column 6, lines 39-45).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an anti-lift device to limit unwanted movement and to give support to the blade and guard (column 6, lines 42-45).

Regarding claims 7 and 8, Kiehne discloses the device substantially as claimed above, but fails to disclose an engagement means on the handle which engages the guard.

However, Gringer teaches engagement means comprising an elongated rib in the handle and a groove in the guard so the guard can slide, but is not allowed to be lifted by the engagement of the rib or rail in the groove (column 6, lines 39-45).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an engagement means involving a rib and a groove since such a mechanism would give support to the blade and guard (column 6, lines 42-45).

8. **Claims 9-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kiehne (WO 01/05312)** in view of **Gringer (US 6,085,607)** and further in view of **Abidin et al (EP 0 55 196 A1)**.

Regarding claim 9, Kiehne in view of Gringer discloses the device substantially as claimed above, but fails to disclose safety catch to prevent excessive retraction.

However, Abidin et al. teaches a safety catch (end stops) comprising a projection to prevent excessive movement of the blade (column 5, lines 51-58)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a safety catch to prevent movement beyond a certain point (column 5, lines 51-52).

Regarding claim 10, Kiehne in view of Gringer discloses the device substantially as claimed above, but fails to disclose a location means to positively locate the guard in the extended position and the retracted position.

However, Abidin et al. teaches an auditory location means that positively locates that the guard has been moved (column 2, lines 56-58; column 3, lines 1-4).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a location means to signal to the user that the blade guard has been moved to a new position (column 2, lines 56-58).

Regarding claim 11, Kiehne in view of Gringer discloses the device substantially as claimed above, but fails to disclose at least one projection which engages at least one recess when the guard is in an extended or retracted position.

However, Abidin et al. teaches a projection (detent member) which engages at least one recess (detent pocket) when the guard is in an extended or retracted position (column 6, lines 3-8 and lines 40-52)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a projection that can hold the guard in the correct position during an operating (retracted) procedure, and a during a transfer (extended) of the device (column 6, lines 40-52).

9. **Claims 12 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kiehne (WO 01/05312)** in view of **Abidin et al (EP 0 55 196 A1)**.

Regarding claims 12 and 15, Kiehne discloses a safety scalpel assembly comprising a scalpel blade attached to a handle of the type which has a blade carrier in the form of a finger, the assembly comprising a scalpel blade having a slot to allow the blade to be attached to the blade carrier on the handle, and a guard which extends at least about the cutting edge of the blade, the guard having attachment means to lock the blade to the guard as the assembly is being attached to the handle and which releases the blade from the guard when the blade is attached to the blade carrier on the

handle, the guard movable relative to the blade between an extended position wherein the guard extends about the cutting edge of the blade and a retracted position, wherein the blade is exposed (page 9, line 24-page 10, line 6), but fails to disclose an anti-lift means.

However, Abidin et al. teaches an anti-lift means to reduce the guard from lifting relative to the handle when the guard is moved between the extended and retracted positions, the anti-lift means comprising an elongate recess (25) in the guard which is adapted to engage a rib (26) located within a recess (27) on one side of the handle, the rib extending along the longitudinal axis (element 26 has a length, and therefore extends along the longitudinal axis), the rib extending through the elongate recess in the guard upon retraction and extension of the guard (Figures 4, 5 and 9).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an engagement means involving a rib and a groove since such a mechanism would give support to the blade and guard (column 5, lines 51-59).

10. **Claims 13 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kiehne (WO 01/05312)** in view of **Abidin et al (EP 0 55 196 A1)** further in view of **Herbert et al. (US 5,868,771)**.

Regarding claims 13 and 14, Kiehne in view of Abidin et al. discloses the invention substantially as claimed above, but fails to disclose a safety catch and a location means.

Herbert et al. discloses a safety catch comprising a peg (225; Figure 7) extending outwardly from one side of the guard, and a location means, the location means comprising a projection (221) on the guard which extend inwardly such that retraction of the guard causes the projection to ride over part of the blade and part of the finger and then to snap behind part of the handle when the guard has been fully retracted, and providing an audible click sound when the projection snaps behind part of the handle (column 5, lines 1-22).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a safety catch and a location means to prevent the guard from sliding back over the blade during the procedure (column 5, lines 16-22).

Response to Arguments

Applicant's arguments filed 5/11/2009 have been fully considered but they are not persuasive.

Regarding claim 1, applicant's amendment to further define the tab as "preventing the cutting edge of the blade from becoming exposed" is not sufficient to differentiate the claimed from prior art. Due to the indefinite nature of the claim, the tab disclosed by Gringer does prevent the cutting edge from being exposed. It is interpreted that the tab of the combination of Kiehne and Gringer is capable of performing the function of preventing the cutting edge of the blade from becoming exposed. The tab (extension, 74) prevents the blade from moving to the forward fully extended position,

and therefore prevents the cutting edge from being exposed from the front of the device. Gringer does not always disclose a portion of the cutting edge being exposed. It is only in the full forward position that the cutting edge is disposed, since the claim language does not disclose the position of the device during which the cutting edge is prevented from being exposed by the tab, Gringer meets the limitations of the claim as currently written.

Applicant's arguments with respect to claim 12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JULIE A. SZPIRA whose telephone number is (571) 270-3866. The examiner can normally be reached on Monday-Thursday 9 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Julie A Szpiral/
Examiner, Art Unit 3731

/Todd E Manahan/
Supervisory Patent Examiner, Art Unit 3734